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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/902,828 07/10/01 ROGERS

D 1368 CIP (TO

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IM52/1002

EXAMINER

MEDLEY, M

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 10/02/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/902828

Applicant(s)

ROGERS

Examiner

MEDLEY

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-15 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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### DETAILED ACTION

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The subject matter "the starting material coal has a free swell index as determined by aforementioned ASTM D 720 test of between about 3.5 and about 5.0 and preferably about 3.75 and about 4.5 are not properly described in the application as filed and consequently raise doubt as to possession of the claimed invention at the time of filing. Applicants are requested to furnish the example a copy of the ASTM D720 and data as to the specific of the coal and its free swell index to fully complete the record.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harnett 3,309,437 combined with GB 1,489,690 Madley et al.

Harnett teaches a porous based product having compressive strength typically in excess of 5,000 psi (note column 4, lines 1-9) when heated to 950°C and an apparent density of 0.93 g/cc (note Table 1 for Examples 4 and 5) and further graphitizing (note column 5, lines 20-44) which anticipates Applicant's claims 1-4. Patentee's apparent density of 0.93 g/cc anticipates/ or in the alternative render obvious Applicant's apparent density of between about 0.1 and about 0.8 g/cm<sup>3</sup> because 0.8 g/cm<sup>3</sup> reads on 0.93 g/cc. Harnett is silent the coal free index swell of between about 3.5 and about 5.0, and preferably between about 3.75 and about 4.5.

It would be obvious to the artisan in the art that the coals of Harnett would inherently have a swell index of about 3.5 and about 5.0, and preferably about 3.75 and about 4.5 in view of Madley. Patentees Madley teaches the artisan in the art that by varying the pretreatment conditions, e.g. temperature and reaction time, the swelling properties of a specific coal can be controlled to a substantial degree for the subsequent use of the coal in a further process step, note page 1 lines 69-75. Madley further teaches a coal having a swell index of 3.5 which encompasses the about 3.5 and about 5.0 range, and suggest the preferred range of about 3.75 and about 4.5 of the instant claims, note the example on page 2 lines 31 to 40 of Madley.

Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harnett 3,309,437 combined with Madley et al GB 1,489,690 in view of Koppelman 4,127,391.

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Harnett teaches a process for producing porous coal-based product produced from coal comprising the steps of heating coal particles in a mold, carbonizing at a temperature over 600°C at heat rate of 10°C, cooling said carbonized body and further graphitizing said carbonized body, note in the entirety, especially Examples 1-2 and 3-12 of table 1, column 1, line 51 to column 2, lines 1-35, column 3, lines 1-22 and 49 to column 4, lines 1-65 and column 6.

Applicants claimed process differs from that of the prior art in that the instant process comprises a soaking step and a controlled cooling step, and specific coal free index swell. It is the Examiner's position that the inclusion of a soaking step and controlled cooling step would be obvious in view of Koppelman. Koppelman teaches a soaking and control cooling step after a carbonizing step for treating coal, note the bridging paragraph of columns 6 and 7. It would be obvious to one of ordinary skill in the art to add the soaking and control cooling steps of the secondary reference to the process of the primary reference as the cooling step because two or more conventional steps to achieve the same cooling steps render the claims obvious.

It would be obvious to the artisan in the art that the coals of Harnett would inherently have a swell index of about 3.5 and about 5.0, preferably about 3.75 and about 4.5 in view of Madley. Patentees Madley teaches the artisan in the art that by varying the pretreatment conditions, e.g. temperature and reaction time the swelling properties of a specific coal can be controlled to a substantial degree for the subsequent use of the coal in a further process step, note page 1 lines 69-75. Madley further teach a coal with a swell index of 3.5 which encompass the

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instant claims coal having a swell index (a) 3.5 and (b) 5.0 range, and suggest the preferred range of (a) 3.75 (a) 4.5, note the example on page 2 lines 31 to 40.

Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harnett 3,309,437 combined with Madley et al GB 1,489,690 in view of Kuroda JP-0811287619A.

Harnett teaches a porous based product having comprehensive strength typically in excess of 5,000 psi (note page 4 lines 1-9) when heated to 950°C and an apparent density of 0.93 g/cc (note Table 1 for examples 4 and 5) and further graphitizing (note column 5 lines 20-44).

Patentee's apparent density of between about 0.1 and about 0.8 g/cm<sup>3</sup> reads on Applicants' apparent density of 0.93 g/cc. Patentee also teaches that formed bodies are used for insulating blocks for furnaces and reactors, filters, etc. (Note column 3 lines 12-22) and that the core products are formed inside containers made of graphite, stainless steel or cardboard (note column 2 lines 4-11).

Applicants instant claims require the core to be laminated sheet product wherein Harnett is silent to the said laminated products being sheet products; It is the examiner's position that it would be obvious to the artisan in the art to use a core between laminate sheets in view of JP '876.

The JP '876 references teach laminated sheets comprising a core of charcoal powder (graphitized coal product) and activated carbon powder (carbonized and coal product) note the English abstract and Figures 1-3. It would be obvious to the artisan in the art to use the laminated sheet with a core of the JP '876 patent as the laminated sheet with the core of Harnett because the

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cores and sheets of JP '876 are of the same nature as the core and container of Harnett to be used for the same intended purposes as laminated products for walls, etc.

It would be obvious to the artisan in the art that the coals of Harnett would inherently have a swell index of @ 3.5 and @ 5.0, preferably @3.75 and @4.5 in view of Madley. Patentees Madley teaches the artisan in the art that by varying the pretreatment conditions, e.g. temperatures and reaction time, the swelling properties of a specific coal can be controlled to a substantial degree for the subsequent use of the coal in a further process step, note page 1 lines 69-75. Madley further teach a coal with a swell index of 3.5 which encompass the instant claimed @3.5 and @ 5.0 range, and suggest the preferred range of @ 3.75 and @ 4.5, note the example on page 2 lines 31-40.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 09/453,729 in view of GB 1,489,690 Madley et al. The instant claimed porous coal-based

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product, method of making and laminated sheet are not patentably distinct from the porous coal-based product, method of making and laminated sheet of related CIP 09/453,729 because the claims are directed to the same coal-based product which would inherently have the same swell index in view of Madley et al teachings that the swell index are conventional controlled and that a swell index of 3.5 is a well-known conventional swell index for coal.

The prior art from the parent application have been reviewed and considered. The prior art cited but not applied further teaches coal and coal based product of the same nature as claimed by applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MMedley:evh

9/27/01

  
MARGARET MEDLEY  
PRIMARY EXAMINER